

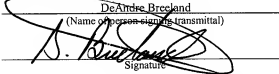
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Shin Iima, et al.
Serial No. : 09/920,883
For : COMMUNICATION APPARATUS,
COMMUNICATION SYSTEM, AND METHOD
OF SAME
Filed : August 02, 2001
Examiner : Lu, Shirley
Art Unit : 2612
Confirmation No. : 5191

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated
November 3, 2006.

ARGUMENTS

This Reply Brief is being filed in response to several points of argument raised by the Examiner in the Examiner's Answer. It is believed that no fee is required for the consideration of this Reply Brief. If, however, a fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any over payment to Deposit Account No. 50-0320.

Claims 1-14 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,698,020 to Zigmond, et al. (hereinafter, merely "Zigmond") in view of U.S. Pub. No. 2002/0010927 to Kim (hereinafter, merely "Kim"). The rejections are traversed for at least the following reasons.

The §103 Rejections Should be Withdrawn Because the Cited References Do Not Disclose Each and Every Element Recited in the Claims

Claim 1 recites, *inter alia*:

"A communication apparatus comprising:

a receiving means for receiving a signal comprised of a program signal and an additional signal;

a separating means for separating the program signal and the additional signal from said received signal;

a determining means for determining whether to output in accordance with said additional signal;

an output signal generating means for generating an output signal by using said separated program signal and additional signal upon determination to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said additional signal; and

wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal;” (Emphasis added)

Appellants respectfully submit that Zigmond and Kim, taken alone or in combination, fail to disclose or suggest a communication apparatus comprising a receiving means for receiving a signal comprised of a program signal and an additional signal wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal, as recited in claim 1.

Kim was filed on January 12, 2001, and claims priority to U.S. Provisional Application 60/176,121 filed on January 14, 2000. The present application has a priority date of August 3, 2000. Thus, Appellants are entitled to an effective filing date of August 3, 2000, which is prior to Kim’s filing date of January 12, 2001.

Upon review of U.S. Provisional Application 60/176,121, Appellants submit that there is no disclosure that would support the rejection. The portion of Kim relied upon by the Final Office Action, paragraph [0076], is not part of U.S. Provisional Application 60/176,121.

The April 7, 2006 Advisory Action argued that the underlined limitation is taught on page one, the first paragraph on page three, the first paragraph on page four and figure 2 of U.S. Provisional Application 60/176,121. Page one merely discloses “that the SO can occupy partially the user’s video presentation device connected to the Free Digital TV receiver to present Banner Information for commercial advertisement purpose”. The first paragraph on page 3 merely discloses “that the Digital TV Service Operator (SO) can present commercial banner advertisement on their video presentation devices.” The first paragraph on page 4 merely discloses “the user’s Free Digital TV receiver receives and demodulates the signal of the channel that the user tuned, decodes and delivers the regular TV programs to the user’s presentation

device, and also decodes, renders, and presents the Banner Information to the user's video presentation device." The cited portions of the provisional application do not teach or suggest that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal.

Therefore, Zigmond and Kim, individually or in combination, fail to teach or suggest a communication apparatus, wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal. Therefore, Zigmond in view of Kim fails to teach or suggest all the limitations recited in claim 1.

Therefore, Appellants respectfully submit that claim 1 is patentable.

Claims 4, 10 and 11 are similar in scope and are patentable for similar reasons.

For at least the foregoing reasons, it is respectfully submitted that independent claims 1, 4, 10 and 11 patentably distinguish over Zigmond and Kim and are therefore allowable. The other claims are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the above-identified reasons. Accordingly, it is submitted that claims 1-14 patentably distinguish over the relied upon portions of the cited references and are allowable.

CONCLUSION

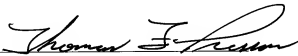
It is respectfully submitted that the Examiner erred in rejecting claims 1-14, and therefore, Appellant requests a reversal of these rejections by this Honorable Board. As a result, the allowance of this application should be mandated.

The Commissioner is hereby authorized to charge any additionally required fee, or to credit any overpayment in such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

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